The opinion in support of the decision being entered today was ***not*** written for publication and is ***not*** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KLAUS GASSENMEIER, WILLI GRAB,
CHRISTOPHE GALOPIN and BEATRICE BIGLER

Appeal No. 2004-1905
Application 09/800,624

ON BRIEF

Before WARREN, WALTZ and KRATZ, *Administrative Patent Judges.*

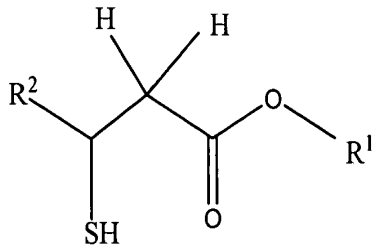
WARREN, *Administrative Patent Judge.*

Decision on Appeal

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 1 through 16, which are all of the claims in the application.

Claim 1 illustrates appellants' invention of a flavor or fragrance composition comprising at least one compound of the structural formula, and is representative of the claims on appeal:

1. A flavor or fragrance composition comprising at least one compound of formula I



or a precursor thereof, wherein R1 represents a branched or unbranched alkyl, alkenyl or alkadienyl group containing 1 to 8 carbon atoms and R2 represents a methyl or ethyl group, in a flavor or fragrance composition.

The references relied on by the examiner are:

Chiba et al. (Chiba) 1 409 209 Oct. 8, 1975
(Patent Specification, United Kingdom)

Food Flavorings, 155-57 (P.R. Ashurst, ed., New York, Blackie Academic & Professional. 1995).

The examiner has rejected appealed claims 1 through 16 under 35 U.S.C. § 103(a) as being unpatentable over Chiba in view of *Food Flavorings*.

Appellants state that the appealed claims "stand and fall together" (brief, page 3). Thus, we decide this appeal based on appealed claim 1. 37 CFR § 1.192(c)(7) (2003).

We affirm.

Rather than reiterate the respective positions advanced by the examiner and appellants, we refer to the answer and to the brief and reply brief for a complete exposition thereof.

Opinion

It is well settled that in order to apply the prior art to a claim, the claim terms must first be interpreted by giving them the broadest reasonable interpretation in light of the written description in the specification as it would be interpreted by one of ordinary skill in this art, without reading into the claim any limitation or particular embodiment which is disclosed in the specification. *See, e.g., In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). The plain language of appealed claim 1 specifies a "composition comprising at least one compound" falling within the structural formula depicted in the claim. Thus, this claim reads on a composition that consists of one such compound *per se*. *See generally, Exxon Chem. Pats., Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1555, 35 USPQ2d 1801, 1802 (Fed. Cir. 1995) ("The claimed composition is defined as comprising - meaning containing at least - five specific ingredients."). Indeed, the written description in appellants' specification discloses that each of the three compounds exemplified in specifications Examples 1-3 are added *per se*, that is, individually and

without inclusion in an intermediate composition, into previously prepared products in specification Examples 4-7.

Accordingly, appealed claim 1 reads on a compound *per se* falling within the depicted structure formula. We find no basis in the use of the terms "flavor or fragrance" in the claim or in any language in the written description of the specification on which to read into claim 1 any limitation or embodiment from the specification. Indeed, with respect to the terms "flavor or fragrance" in the claim, appellants disclose in the written description in the specification that each of the compounds encompassed by the structural formula depicted in the claim are flavor or fragrance agents.

In comparing appealed claim 1 as we have interpreted this claim above, with Chiba,[1,2] we find that the reference discloses the compound "methyl 3-mercaptobutyrate" which is also named 3-mercaptobutanoic acid methyl ester in the specification (page 3, line 14). Chiba discloses the compound of Example 4 as "a single compound, free of impurities" (page 4, lines 19-20).

Accordingly, *prima facie*, as a matter of fact the compound of Chiba Example 4 falls within appealed claim 1 as we have interpreted this claim above, and satisfies each and every element of the claimed composition, arranged as required therein, either expressly or under the principles of inherency, establishing that the claimed composition encompassed by claim 1 lacks novelty.[3] Thus, while the issue here has been framed by the examiner as one of obviousness under § 103(a), the evidence of a lack of novelty of the claimed composition as encompassed by claim 1 is, of course, "the *ultimate* obviousness." *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982). To the extent that the compound disclosed by Chiba

---

[1] A discussion of *Food Flavorings* is unnecessary to our decision. *See In re Kronig*, 539 F.2d 1300, 1302-04, 190 USPQ 425, 426-28 (CCPA 1976).

[2] We have not considered the United States Patents cited by the examiner at page 5 of the answer because the same do not appear in the statement of the ground of rejection. *See In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970).

[3] In order to establish a lack of novelty, each and every element of the claimed invention, arranged as required by the claim, must be described identically in a single reference, either expressly or under the principles of inherency, in a manner sufficient to have placed a person of ordinary skill in the art in possession thereof. *See generally, In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

anticipates the claimed compositions encompassed by claim 1, the case of obviousness is irrebuttable. *Id.*

Accordingly, since a *prima facie* case of obviousness has been established over Chiba, we have again evaluated all of the evidence of obviousness and nonobviousness based on the record as a whole, giving due consideration to the weight of appellants' arguments in the brief and reply brief including the Galopin declaration under 37 CFR § 1.132[4] to the extent that it is relied on in the brief and reply brief. *See generally, In re Johnson*, 747 F.2d 1456, 1460, 223 USPQ 1260, 1263 (Fed. Cir. 1984); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

We have considered appellants' response in the reply brief (pages 2-3) to the examiner's argument that the flavor imparted by the compound of Chiba Example 4 is an inherent property of the compound (answer, page 5). In view of the claim encompassing the compound *per se*, it is well settled that "[t]he discovery of a new property or use of a previously known composition, even when that property and use are unobvious from the prior art, cannot impart patentability the claims to the known composition. [Citations omitted.]." *Spada*, 911 F.2d at 708, 15 USPQ2d at 1657, and case cited therein.

We have also considered the Galopin declaration but do not find therein any evidence which patentably distinguishes appealed claim 1 over the compound of Chiba Example 4. *Fracalossi*, 681 F.2d at 794, 215 USPQ at 571.

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of obviousness found in the combined teachings of Chiba and *Food Flavorings* with appellants' countervailing evidence of and argument for nonobviousness and conclude that the claimed invention encompassed by appealed claims 1 through 16 would have been obvious as a matter of law under 35 U.S.C. § 103(a).

The examiner's decision is affirmed.

Other Issues

In the event of further prosecution of the appealed claims before the examiner subsequent

[4] The declaration was filed August 27, 2003.

to the disposition of this appeal, we suggest that the examiner consider "Swiss patent 557 423" acknowledged by appellants in the specification (pages 1-2). It appears from appellants' disclosure that this document discloses the next adjacent homologues of compounds falling within the structural formula of appealed claim 1, and are described by appellants as "3-mercapto carboxylic esters known as flavor or fragrance compounds" (specification, page 2, lines 1-17). We further suggest that the examiner consider the other patent and scientific literature documents acknowledged by appellant to disclose "3-mercaptoalkanoic acid esters according to the present invention" (specification, page 7, lines 1-8). We decline to exercise our authority under 37 CFR § 1.196(b) (2003) and enter on the record a new ground of rejection based on these documents, leaving it to the examiner to make factual findings therefrom along with any other applicable prior art developed by the examiner.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

CHARLES F. WARREN)
Administrative Patent Judge)
)
)
THOMAS A. WALTZ) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
)
PETER F. KRATZ)
Administrative Patent Judge)

Wood, Herron & Evans, LLP
2700 Carew Tower
441 Vine Street
Cincinnati, OH 45202